

REMARKS

Applicant submits this Amendment in reply to the final Office Action mailed June 3, 2010.

By this Amendment, Applicant amends claim 1, 16, 28, and 30-32. The originally filed specification, drawings, and claims fully support the subject matter of claims 1, 16, 28, and 30-32. Claims 1, 3-6, 8, 9, 11-18, and 28-33 are pending in this application, with Claims 1, 16, and 30 being the sole independent claims.

As an initial matter, Applicant would like to thank Examiner Nguyen for the courtesy of the telephone interview ("the interview") conducted with Applicant's representative on July 23, 2010. During the interview, the pending claims and the rejections based on U.S. Patent No. 5,607,389 to Edwards ("the '389 Edwards patent"); U.S. Patent Application Publication No. 2001/0014779 to Burbank et al. ("Burbank"); and U.S. Patent No. 6,692,490 to Edwards ("the '490 Edwards patent") were discussed. Features distinguishing the pending claims from the cited references were also discussed. The amendments to the claims set forth above and the remarks made herein are consistent with discussion and agreements made during the interview.

On page 2 of the Office Action, claims 1, 3-5, 8, 9, and 11-18 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the '389 Edwards patent. Applicant traverses this rejection.

A proper anticipation rejection requires each and every element set forth in the claim to be found in a single prior art reference. MPEP § 2131. The '389 Edwards patent does not disclose each and every feature of the claimed invention. For example,

independent claim 1 recites a biopsy system comprising, among other aspects, a first placeholder element and a handle "including a handle fitting projecting distally from a distally facing surface of the handle configured to be received by a correspondingly shaped placeholder fitting in a proximal end of the first placeholder element and to be removed from the placeholder fitting when the handle fitting and the placeholder fitting are twisted relative to each other so that the first placeholder element may be left in the first selected position." As-amended independent claim 30 includes similar recitations. The '389 Edwards patent does not disclose at least this aspect of the claimed invention either alone or in combination with other aspects of the claimed invention.

Page 2 of the final Office Action asserts that, with respect to the '389 Edwards patent, torque tube 312 corresponds to the claimed first placeholder element, and upper and lower handle plates 276, 300, collectively, correspond to the claimed handle. Further, the final Office Action cites Fig. 6, to support the contention that upper and lower handle plates are removably coupled to torque tube 312. See page 2 of the final Office Action. Although Applicant does not agree with the Office's assertions, in an effort to advance prosecution, Applicant has amended claims 1 and 30 to recite that the claimed handle includes "including a handle fitting projecting distally from a distally facing surface of the handle configured to be received by a correspondingly shaped placeholder fitting in a proximal end of the first placeholder element and to be removed from the placeholder fitting when the handle fitting and the placeholder fitting are twisted relative to each other so that the first placeholder element may be left in the first selected position."

In rejecting dependent claim 28, the Office asserts that torque coupler 314 and control knob 316, together, correspond to the claimed handle fitting. See page 4 of the final Office Action. Even assuming that is correct, which Applicant does not concede, the '389 Edwards patent does not disclose, teach, or otherwise suggest that the torque tube 312 can be removed from the torque coupler 314 and control knob 316, collectively, when torque tube 312 is twisted relative to both torque coupler 314 and control knob 316, as required by amended claims 1 and 30. Instead, the '389 Edwards patent teaches that torque tube 312 is joined to torque coupler 314. See col. 9, lines 13-14 of the '389 Edwards patent. Additionally, it appears from Fig. 7 and col. 9, lines 11-29 of the '389 Edwards patent that torque tube 312 rotates with torque twist control knob 316 so that twist control knob 316 can impart torque on torque tube 312.

Accordingly, the '389 Edwards patent does not disclose the claimed combination including a handle "including a handle fitting projecting distally from a distally facing surface of the handle configured to be received by a correspondingly shaped placeholder fitting in a proximal end of the first placeholder element and to be removed from the placeholder fitting when the handle fitting and the placeholder fitting are twisted relative to each other so that the first placeholder element may be left in the first selected position," as recited in as-amended claims 1 and 30.

Applicant has amended dependent claims 28, 31, and 32 to further distinguish from the claimed invention from the cited art.

On page 5 of the final Office Action, claims 30-33 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Burbank. Applicant traverses this rejection.

A proper anticipation rejection requires each and every element set forth in the claim to be found in a single prior art reference. MPEP § 2131. Burbank does not disclose each and every feature of the claimed invention. As-amended independent claim 30 recites a biopsy system comprising, among other aspects, a first placeholder element and a "handle including a handle fitting projecting distally from a distally facing surface of the handle configured to be received by a correspondingly shaped placeholder fitting in a proximal end of the first placeholder element." Burbank does not disclose at least this aspect of the claimed invention either alone or in combination with other aspects of the claimed invention.

Page 5 of the final Office Action refers to Fig. 1 of Burbank and asserts that probe 102 corresponds to the claimed first placeholder element and base unit 104 corresponds to the claimed handle. Even assuming that is correct, which Applicant does not concede, Burbank fails to disclose, teach, or otherwise suggest that base unit 104 includes "a handle fitting projecting distally from a distally facing surface of the handle configured to be received by a correspondingly shaped placeholder fitting in a proximal end of the first placeholder element," as recited in as-amended claim 30. Indeed, Burbank includes no disclosure of a fitting extending distally from a distally facing surface of base unit 104.

Accordingly, Burbank does not anticipate as-amended independent claim 30.

Independent claim 30 is allowable for at least this reason. Further, rejected claims 31-33 depend directly or indirectly from independent claim 30 and are therefore allowable for at least the same reasons as independent claim 30 is allowable as well as for their additional features.

On page 6 of the final Office Action, claims 16 and 29 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Burbank in view of the '490 Edwards patent. Applicant respectfully traverses this rejection.

Neither Burbank nor the '490 Edwards patent, taken alone or in combination, discloses, teaches, or otherwise suggests the claimed invention. For at least the reasons stated above, Burbank fails to disclose or suggest "a handle fitting projecting distally from a distally facing surface of the handle configured to be received by and removed from a correspondingly shaped fitting in a proximal end of the first placeholder element," as recited in as-amended claim 16. The Examiner has relied upon the '490 Edwards patent for the alleged teaching of a multi-barbed electrode. Even if the '490 Edwards patent teaches what the Examiner alleges (and Applicant does not necessarily agree that it does), this reference fails to overcome the deficiencies of Burbank.

For at least this reasons, Applicant submits independent claim 16 is allowable.

Further, rejected claim 29 depends directly or indirectly from independent claim 16 and is therefore allowable as well as for its additional features.

On page 7 of the final Office Action, claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the '389 Edwards patent¹ in view of U.S. Patent No. 6,213,957 to Milliman et al. ("Milliman"). Even if Milliman teaches what the Examiner alleges, which Applicant does not concede, Milliman fails to overcome the aforementioned deficiencies of the '389 Edwards patent. Claim 6 therefore is at least

¹ On page 7 of the final Office Action, the Examiner rejects claim 6 under 35 U.S.C. § 103(a) as being unpatentable over "Edwards et al in view of Milliman et al US 6,213,957." Applicant assumes the Office is referring to the '389 Edwards patent. Applicant requests clarification if our understanding is incorrect.

allowable due to its dependence on claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the Section 103(a) rejection of claim 6 based on the '389 Edwards patent and Milliman.

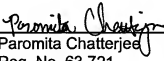
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 30, 2010

By: 
Paromita Chatterjee
Reg. No. 63,721
(202) 408-4000